IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant	: Jonathan S. Stinson	Art Unit	: 1742
Serial No.	: 10/672,891	Examiner	: Jessee Randall Roe
Filed	: September 26, 2003	Conf. No.	: 9546
Title	: MEDICAL DEVICES AND METHODS OF MAKING SAME		

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REPLY BRIEF

Pursuant to 37 C.F.R. § 41.41, Appellant responds to the Examiner's Answer as follows.

At page 16, lines 18-22 of the Examiner's Answer, the Examiner newly asserts that because "stents [are] too expensive to be replaced after each use . . . one having ordinary skill in the art of stent design would be motivated to know and apply the composition of alloys used for an autoclave (especially the internal parts), which would include the tantalum-titanium alloys disclosed by Lenning et al. ('503), to medical equipment because the composition of these internal parts would be subject to constant exposure to temperatures of up to 800°F, as would be the medical equipment during sterilization." The autoclavability of the materials used to produce a stent is simply not an issue that would concern one having ordinary skill in the art of stent design. Stents are not reused. Accordingly, one having ordinary skill in the art of stent design would not have any reason to look at the non-analogous art of autoclave materials when designing a stent.

On page 17, lines 6-8 of the Examiner's Answer, the Examiner newly asserts that one would find it obvious to use the autoclave alloy of Lenning in the stent of Lau because "Lenning et al. ('503) also discloses that the alloy would have high strength in addition to good ductility up to about 800°F, which would include room temperature (col. 2, lines 20-41)." One having ordinary skill in the art of stent design would not find this disclosure of Lenning to be sufficient to suggest that the alloy of Lenning has the correct combination of physiological and mechanical properties suitable for use in a stent. In context, it only suggests that the alloy does not become brittle after a heating operation up to 800 °F. A stent, in use, is not subjected to temperatures

even close to 800°F when implanted in a body lumen. Moreover, there is no indication that the Lenning alloys have the right combination of mechanical properties for use in a stent. The asserted properties of "high strength" and "good ductility" are also are not specific enough to suggest that the alloy of Lenning has the right combination of mechanical properties suitable for use in a stent. Accordingly, the Examiner's new argument still fails to provide any logical reason for why one having ordinary skill in the art of stent design would look to the non-analogous art of autoclave material and select one of the autoclave alloys disclosed by Lenning to produce the stent of Lau. Accordingly, the combination of Lau and Lenning remains improper.

On page 18, lines 18-22 and page 20, lines 4-6 of the Examiner's Answer, the Examiner newly argues that the Appellant's argument regarding the "lack of contact with bone" is misplaced because this feature is "not recited in the rejected claims(s)." This statement demonstrates that the Examiner misunderstood the Appellant's argument. The Appellant's argument is that one having ordinary skill in the art would not make the asserted combination because she would recognize that the advantages disclosed by Steinemann are inapplicable to stents. The relevant inquiry for evaluating the sufficiency of an alleged combination is whether one having ordinary skill in the art would have made the asserted combination at the time of invention. Here, one would recognize that the advantages disclosed by Steinemann are only applicable to implants that bridge bone, such as bone screws, and that the stents disclosed by Fischell do not bridge bone. Whether the Appellant's claim recites the aspects of the prior art that suggest against the combination is irrelevant to the inquiry of whether one having ordinary skill in the art would make the asserted combination. Appellant has never suggested that the claims require that the claimed stent not bridge bone, only that there is no suggestion in Fischell that the stent of Fischell ever bridges bone. Accordingly, the Examiner's new argument is irrelevant and non-responsive to the Appellant's argument.

On page 20, lines 6-8 of the Examiner's Answer, the Examiner newly asserts that "the strength of the alloys used for stents would be considered because one skilled in the art would desire long-term use and a minimization of breakage during use." This statement is without support and fails even to address the Appellant's position that the "high strength" disclosed by

Steinemann is only applicable for bridging bone, as set forth in the Appeal Brief. One having ordinary skill in the art of stent design would recognize that the "high strength" disclosed by Steinemann would not translate to increased "long-term use" or "a minimization of breakage during use" when used in a stent because the stent of Fischell does not bridge bone. Again, the Examiner has failed to address the disclosures of the prior art that suggest against the alleged combination. Furthermore, Appellant never argued that the alloy of Steinemann is not biocompatible. On the contrary, Appellant only pointed out that Steinemann itself recognizes that titanium is sufficiently biocompatible and corrosion resistant. The alloys of Steinemann are not disclosed as being any more biocompatible or corrosion resistant than titanium, but only as being better at bridging bone than titanium. Accordingly, one having ordinary skill in the art of stent design would not have any reason to substitute the bone bridging alloy of Steinemann for the titanium in the stent of Fischell as asserted by the Examiner.

For these reasons, and the reasons stated in the Appeal Brief, Appellant submits that the final rejection should be reversed.

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Respectfully submitted,

Date: 10/3/2008

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